

REMARKS

In the outstanding *Office Action*, new Claims 38-44 were withdrawn from consideration as drawn to an independent invention. Reconsideration of that item is requested for the reasons set forth below.

The previous rejections under 35 USC §112, 35 USC §102 and 35 USC §103 were withdrawn.

Claims 1-16, 21-29, 36-37 were rejected under 35 USC §112, second paragraph because they used the transitional phrase "consisting essentially of". Reconsideration of that item is also requested for the reasons stated below.

Claims 1-16, 21-29 and 36-37 were rejected as 35 USC §103(a) as being unpatentable over *Shanton*, United States Patent No. 5,776,619. Reconsideration of these rejections is likewise requested for the reasons discussed below.

Turning first to the withdrawal of Claims 38-44, it is believed clear that the new claims, while differing in scope from Claim 1, are directed to the same disclosed embodiment of the invention (no filler, *see* Table 1, page 16 of the application as filed; *Note also* Examples 2-3, 5-7 and 9-10 particularly). MPEP §806.03 makes clear that claims of different scope to the same embodiment should not be restricted out. For convenience, §806.03 is reproduced below. Also Claims 1 and 38 are reproduced side-by-side for comparison.

806.03 Single Embodiment, Claims Defining Same Essential Features

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition. Where such claims appear in different applications optionally filed by the same inventor, disclosing the same embodiments, *see* MPEP § 804 - § 804.02.

Claim 1	Claim 38
<p>A disposable shaped paperboard food container with a bilayer finish press-formed in a heated die set from a paperboard blank,</p> <p>said paperboard blank being prepared from a paperboard substrate provided with a first finish coating layer consisting essentially of a styrene-butadiene resin composition and a second, top coating finish layer consisting essentially of an acrylic resin composition applied to said first finish coating layer wherein said first and second coatings contain up to about 2 lbs of mineral filler per 3,000 square foot ream and, wherein said food container exhibits a surface gloss of at least about 40 gloss units as measured by test method ASTM D523-89, 60 degree method.</p>	<p>A disposable shaped paperboard food container with a bilayer finish press-formed in a heated die set from a paperboard blank,</p> <p>said paperboard blank being prepared from a paperboard substrate provided with a first finish coating layer consisting essentially of a styrene-butadiene resin composition without mineral filler and a second, top coating finish layer consisting of an acrylic resin composition without mineral filler applied to said first finish coating layer, wherein said food container exhibits a surface gloss of at least about 40 gloss units as measured by test method ASTM D523-89, 60 degree method.</p>

It is believed Applicant is entitled to examination of Claims 38-44 in this application.

Unfilled topcoat layers are a preferred embodiment; however, some amount of filler could be employed as is noted on pages 4-5 of the application as filed:

The first finish coating composition consists essentially of a styrene-butadiene resin composition that includes a styrene-butadiene resin, crosslinking agents and so forth, but does not include a substantial amount of mineral fillers which would alter the basic and novel characteristics of the invention, i.e., enhanced gloss, increased wet and dry rigidity and reduced moisture pickup. Preferably, the styrene-butadiene resin composition contains no mineral filler whatsoever. Likewise, the acrylic resin composition forming the second or top finish layer includes an acrylic resin, crosslinking agents and so forth, but does not include substantial amounts of mineral filler which would alter the basic and novel characteristics of the present invention. Preferably, the acrylic resin composition contains no mineral filler whatsoever; in some embodiments, however, it may be possible to add up to about 2 lbs of mineral filler per 3,000 square foot ream in the two finish layers while maintaining enhanced gloss and performance characteristics.

As to the claim rejection, because of the transitional phrase "consisting essentially of", this rejection is also inconsistent with the MPEP, notably §2111.03 as well as the disclosure quoted above and accordingly, should be withdrawn. 2111.03 provides in relevant part:

2111.03 Transitional Phrases

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original) (Prior art hydraulic fluid required a dispersant which appellants argued was excluded from claims limited to a functional fluid "consisting essentially of" certain components. In finding the claims did not exclude the prior art dispersant, the court noted that appellants' specification indicated the claimed composition can contain any well-known additive such as a dispersant, and there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention. The prior art composition had the same basic and novel characteristic (increased oxidation resistance) as well as additional enhanced detergent and dispersant characteristics.). "A 'consisting essentially of' claim occupies a middle ground between closed claims that are written in a 'consisting of' format and fully open claims that are drafted in a 'comprising' format." *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. vs. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase 'consisting essentially of' for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). See also *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989) ("Although 'consisting essentially of' is typically used and defined in the context of compositions of matter, we find nothing intrinsically wrong with the use of such language as a modifier of method steps. . . [rendering] the claim open only for the inclusion of steps

which do not materially affect the basic and novel characteristics of the claimed method. To determine the steps included versus excluded the claim must be read in light of the specification. . . . [I]t is an applicant's burden to establish that a step practiced in a prior art method is excluded from his claims by 'consisting essentially of' language.'").

The MPEP expressly sanctions the use of the transitional phrase "consisting essentially of" and Applicant is entitled to so claim the invention. The rejections should be withdrawn.

Turning to the rejections made on art, these should be withdrawn for at least two reasons.

For one, the art rejections do not meet the standards articulated in *In re Lee*, 61 USPQ2d 1430, 1433 (CAFC 2002) which require specificity as to how and why the prior art teaches a claimed combination:

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Roufflet*, 49 F.3d 1350, 1359, 47 USPA2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.

The general allegations in the *Office Action* of September 23, 2003 are inadequate.

Shanton is devoid of any teaching which would motivate one of skill in the art to arrive at the combinations claimed in this case. At a minimum, the art must teach where variables are result-oriented to a particular result before they can be "optimized" as asserted in the *Office Action*. Here, the reference teaches away as noted below.

Furthermore, *Stanton* '619 expressly teaches not to use an SBR undercoat as is claimed in this application:

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Several different polymer formulations were investigated for forming the latex portion of the coating composition of the present invention. A polyvinyl acetate/acrylate polymer latex in the top coat and a styrene butadiene latex in the base coat currently used in a packaging grade application were tested, but were found to produce a plate coating with poor plate properties, especially grease resistance.

The outstanding art rejections are untenable.

In view of the above, this application should be allowed; the withdrawn claims are narrower in scope than the other allowable claims and do not raise additional issues of patentability.

In view of the final notice of the *Office Action* and the numerous issues in the *Office Action*, Counsel will call to discuss.

Respectfully submitted



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